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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/068,438 | 02/06/2002 | Hiroaki Yamamoto | 020357 085P2 | 9528 |

33805 7590 07/30/2003

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EXAMINER

CHEVALIER, ALICIA ANN

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1772

DATE MAILED: 07/30/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

10/068,438

Applicant(s)

YAMAMOTO, HIROAKI

Examiner

Alicia Chevalier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group I, claims 1-9, in Paper No. 8 is acknowledged.

Specification

2. The abstract of the disclosure is objected to because it contains more than 150 words. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Hirose (6,171,543).

Hirose discloses a rocker panel comprising a plastic automotive part (references #230, 232 and 234) and a clip house member (references #246, 244 and 242) connected to said part, said plastic automotive part comprising a top show surface (references #230 and 232) and a side show surface (reference # 234) connected to said top show surface and extending away from said top show surface from a junction (reference #263) formed between said top show surface and

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said side show surface, said clip house comprising a first support member (reference #244) connected to said automotive part at said juncture (see figure 3). The juncture (reference #263) comprises a rib (reference #262) with a channel (reference #260) formed therein. The clip house further comprises a second support member (reference #242), said second support member connected to said top show surface at a location spaced from said juncture. Said clip house further comprises a web (reference #246) connecting said first support member and said second support member.

The limitation “said house member being adapted to provide a mounting attachment to secure said automotive part to a corresponding mounting member of an automotive structural part” in claim 1 is a functional limitation(s). As defined in the MPEP, “[a] functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure or specific ingredients). There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971)” - MPEP § 2173.05(g). However, the examiner notes that “where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an ***inherent characteristic of the prior art***, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristics relied on” (emphasis added) - MPEP § 2183.

In the instant case, the claimed limitation(s) “said house member being adapted to provide a mounting attachment to secure said automotive part to a corresponding mounting member of an automotive structural part” is a functional limitation(s) and is deemed to be an

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inherent characteristic of the prior art since the prior art is substantially identical in composition and/or structure. The examiner's sound basis for this assertion is based on Kreis having the same structure.

Process limitations are given little or no patentable weight. The method of forming the product is not germane to the issue of patentability of the product itself. Further, when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. *In re Brown*, 459 F.2d 531, 173 USPQ 685 (CCPA 1972); *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974). This burden is NOT discharged solely because the product was derived from a process not known to the prior art. *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974).

Furthermore, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 946, 966 (Fed. Cir. 1985) and MPEP §2113. In this case, the limitation "unitary molded structure" in claim 5 is a method of production and therefore does not determine the patentability of the product itself.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kreis (5,609,004) in view of Vollrath (4,850,638).

Kreis discloses a body frame part of an automobile (see the field of the invention) comprising an automotive part (reference #6) and a clip house member (reference #15) connected to said part, said plastic automotive part comprising a top show surface (the outer wall, reference #6, on the right hand side of the figure) and a side show surface (the outer wall, reference #6, at the bottom of the figure) connected to said top show surface and extending away from said top show surface from a junction (reference #14) formed between said top show surface and said side show surface, said clip house comprising a first support member (the part of reference #15 which extends from reference #14) connected to said automotive part at said juncture (see figure 1). The juncture (reference #14) comprises a rib with a channel formed therein. The clip house further comprises a second support member (the part of reference #15 which extends to the upper right hand corner of the outer wall reference #6), said second support member connected to said top show surface at a location spaced from said juncture. Said clip house further comprises a web (the part of reference #15 which extends to the left side of the outer wall reference #6) connecting said first support member and said second support member.

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The automotive part (reference #6) can further be seen to have a substantially planar horizontal top portion (the outer wall, reference #6, on the right hand side of the figure) with first and second longitudinally extending edges a side portion (the outer wall, reference #6, at the bottom of the figure) with a longitudinally extending edge connected to said longitudinally extending edge of said top portion, a longitudinally extending reinforcing rib (reference #14) with first and second foot portions connected such that said foot portion is attached to said top portion near said first edge of said top portion and said second foot portion is attached to said side portion near said edge that a longitudinally extending hollow channel is defined and said clip house mounting structure (reference #15) further comprises a clip mounting member with an upper portion (the part of reference #15 which extends to the upper right hand corner of the outer wall reference #6) attached to said second longitudinally extending edge of said top portion and a lower portion attached to said reinforcing rib (the part of reference #15 which extends from reference #14). The clip house mounting structure further comprises a structural support member with first and second ends and is attached such that said first end connects to said lower portion of said mounting member and said second end connects to said reinforcing rib (reference #15). The clip house further comprising a web portion connected to said clip mounting member the part of reference #15 which extends to the left side of the outer wall reference #6). See the figure.

Kreis disclose all the limitations of the instant claimed invention except that the automotive part is made of metal instead of the instant claimed plastic.

Vollrath discloses a body frame part of an automobile. Vollrath further teaches that it is considerably cheaper if these parts are formed as plastic mouldings or light metal castings, which

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is preferable, since by this means a good dimensional accuracy of these parts is obtained, and in consequence the bodywork can be assembled so as to be completely free of distortion and stress and the signs of fatigue which can usually be observed because of internal stress are avoided (col. 1, lines 37-61).

It would have been obvious to one of ordinary skill in the art at the time of the invention to use plastic for the automotive part of Kreis because Vollrath teaches that plastic mouldings or light metal castings are considerably cheaper and have good dimensional accuracy.

The preamble in claim 6, "rocker panel," is an intended use of the combination of the plastic automotive part and a clip house member and does not add structure to the body of the claim.

The limitation "said house member being adapted to provide a mounting attachment to secure said automotive part to a corresponding mounting member of an automotive structural part" in claim 1 is a functional limitation(s). As defined in the MPEP, "[a] functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure or specific ingredients). There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971)" - MPEP § 2173.05(g). However, the examiner notes that "where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be a *necessarily present characteristic of the prior art*, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristics relied on" (emphasis added) - MPEP § 2183.

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In the instant case, the claimed limitation(s) “said house member being adapted to provide a mounting attachment to secure said automotive part to a corresponding mounting member of an automotive structural part” is a functional limitation(s) and is deemed to be a necessarily present of the prior art since the prior art is substantially identical in composition and/or structure. The examiner’s sound basis for this assertion is based on Kreis having the same structure.

Process limitations are given little or no patentable weight. The method of forming the product is not germane to the issue of patentability of the product itself. Further, when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. *In re Brown*, 459 F.2d 531, 173 USPQ 685 (CCPA 1972); *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974). This burden is NOT discharged solely because the product was derived from a process not known to the prior art. *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974).

Furthermore, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 946, 966 (Fed. Cir. 1985) and MPEP §2113. In this case, the limitation “unitary molded structure” in claim 5 is a method of production and therefore does not determine the patentability of the product itself.

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Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Panoz et al. (6,357,822), Maki et al. (5,639,522) and Watanabe et al. (4,363,839) all disclose similar combinations.

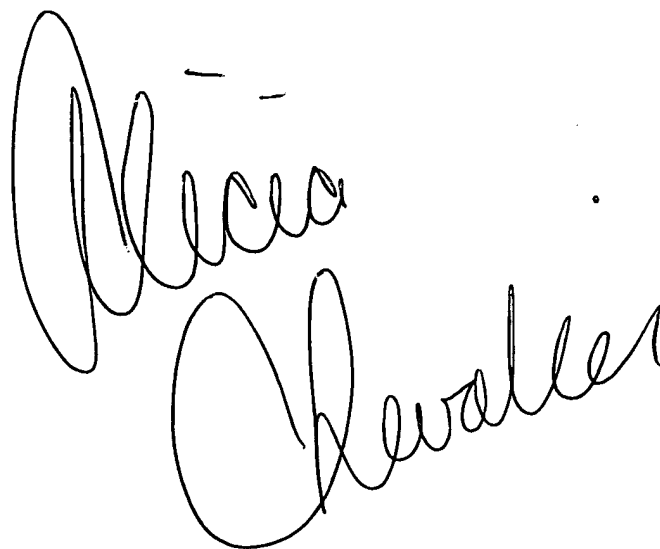
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (703) 305-1139. The Examiner can normally be reached on Monday through Thursday from 8:00 a.m. to 5:00 p.m. The Examiner can also be reached on alternate Fridays

If attempts to reach the Examiner are unsuccessful, the Examiner's supervisor, Harold Pyon can be reached by dialing (703) 308-4251. The fax phone number for the organization official non-final papers is (703) 872-9310. The fax number for after final papers is (703) 872-9311.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose phone number is (703) 308-0661.

ac

7/17/03

A handwritten signature in black ink, reading "Alicia Chevalier". The signature is written in a cursive style with large, flowing loops. The first name "Alicia" is on the top line, and the last name "Chevalier" is on the bottom line, with a large loop at the end of the last name.